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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,241	08/08/2001	Shao Fang	13167US01	3646

7590 08/04/2004

McAndrews, Held & Malloy, Ltd.  
34th Floor  
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Chicago, IL 60661

EXAMINER
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INGBERG, TODD D

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/925,241

Applicant(s)

FANG ET AL.

Examiner

Todd Ingberg

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/26/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1 – 24 have been examined.

#### ***Drawings***

1. The drawings were received on January 9, 2002. These drawings are accepted.
2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Information Disclosure Statement***

3. The Information Disclosure Statement filed on November 26, 2001 has been considered.

#### ***Priority***

4. Claim to domestic priority with application 60/164,164 with the effective filing date of August 23, 1999 has been reviewed and granted.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 14 – 15 and dependent claim 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A clear and concise meaning for “arbitrary action” is needed. Arbitrary implies indefinite. Results from the execution of a rule should be deterministic not arbitrary. Clarification is needed.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 20 of the claimed invention are non-statutory because they fail the ***concrete*** and ***tangible*** tests of 35 U.S.C. § 101. This rejection can easily be overcome with the following amendment.

**Claim 1**

A framework **implemented on a computer readable medium** for implementing and deploying personalized rules for performing certain actions in association with at least one: application running on a processor device in a distributed computer network, the framework comprising:

- at least one rule having a set of conditions and associated actions;
- at least one application page associated with each application; and
- at least one tag defined in a known location of the at least one application page, wherein a rule is deployed by associating certain actions with certain tags, with the action being executed when the tag is encountered in rendering the application page, and the set of conditions for the associated rule is satisfied.

**Claim 14**

A framework **implemented on a computer readable medium** for implementing and deploying personalized rules for performing certain actions in association with at least one application running on a processor in a distributed computer network, the framework comprising:

- at least one rule having a set of conditions, the set of conditions being associated with an arbitrary action;
- at least one application page associated with each application; and

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at least one tag defined in a known location of the at least one application page, wherein a rule is deployed by associating the arbitrary action with certain tags, with the arbitrary action being executed when the tag is encountered in rendering the application page, and the set of conditions for the rule are satisfied.

Claim 17

A tool implemented on a computer readable medium for implementing and deploying personalized rules for performing certain actions in association with at least one application running on a processor in a distributed computer network, the tool comprising:

at least one interface for creating rules having a set of conditions, the set of conditions being associated with at least one action, whereby the rules are retrievably stored;

at least one interface for searching and retrieving a list of created and existing rules; and

at least one interface for deploying the rules by selectively associating the actions of certain rules with certain tags, each tag having been defined in a known location of the at least one application, wherein the action is executed when the tag is encountered in the process of rendering the application, and the set of conditions for the associated rule are satisfied.

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Template Software's commercial product Workflow System copyright date of documentation 1998 in view of **Malcolm** USPN # 6,620,204 filed November 25, 1997.

The **Template** product line contains:

The SNAP programming language ( Not used in this Office Action)

The Workflow Template (-Portions of two manuals used)

The Web Component ( Not used in this Office Action)

These three layered products work together.

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The documentation sets for the products contains the following manuals.

**SNAP** released June 1997

SNAP Language Reference ( Not used in this Office Action)

Using the SNAP Language ( Not used in this Office Action)

Using the SNAP Communication Component ( Not used in this Office Action)

Using the SNAP Graphic User Interface Component ( Not used in this Office Action)

Getting Started with SNAP ( Not used in this Office Action)

Using the SNAP Display Editors ( Not used in this Office Action)

SNAP Class Library Reference ( Not used in this Office Action)

Using the SNAP External Application Software Component ( Not used in this Office Action)

Using the SNAP Development Environment ( Not used in this Office Action)

SNAP Module Library Reference ( Not used in this Office Action)

Using the SNAP Permanent Storage Component ( Not used in this Office Action)

**Workflow** released September 1997

Developing a WFT Workflow System (Referred to as **WFT** portion of manual)

Using the WFT Development Environment (Referred to as **Using** portion of manual)

WFT Library Reference ( Not used in this Office Action)

**Web Component**

Using the Web Component ( Not used in this Office Action)

Since, these products work together they constitute a single reference and can be used as the basis for a rejection based on anticipated by a product offering. Furthermore, with the 1997 press

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release announcing version 8.0 these considered prior art under *In re Epstein* 31 USPQ2d 1817

(decided August 17, 1994) with a 1997 release date despite the 1998 copyright date.

#### **Claim 1**

**WFT** teaches a framework for implementing and deploying personalized rules (**WFT**, page 4-27, Rules and conditions) for performing certain actions in association with at least one (**WFT**, in example for over budget the action is a REFUSAL): application running on a processor device in a distributed computer network (**WFT**, a distributed Workflow system – page 1-3 Deploying a WFT Workflow System – nodes and servers), the framework comprising:

- at least one rule having a set of conditions and associated actions (**WFT**, page 4-27, Rules and conditions);

- at least one application page associated with each application actions (**WFT**, page 4-27, Rules and conditions); and

Although **WFT** teaches rules in a workflow system and generates HTML (**WFT**, 2-18), **WFT** does not teach the framework implemented in a tagged environment. It is **Malcolm** who teaches the framework for definition of tagged language in support of implementing Rules.

- at least one tag defined in a known location of the at least one application page (**Malcolm**, figure 3 Rules to object to lookup engine to dictionary and correlation table as described col 10, lines 25 – 55),

wherein a rule is deployed by associating certain actions with certain tags, with the action being executed when the tag is encountered in rendering the application page, and the set of conditions for the associated rule is satisfied (**Malcolm**, figure 3 Rules to object to lookup engine to dictionary and correlation table as described col 10, lines 25 – 55 – Also Rules by definition as stated in objection to Figure 1).

Therefore, it would have been obvious to combine the teaching of **WFT** with **Malcolm**, because the it allows for automatic code generation (**Malcolm**, col 2, lines 65 to end).

#### **Claim 2**

The framework of Claim 1, wherein the rule is deployed in a runtime environment by associating the rule actions with certain tags that are executed during runtime. (**Malcolm**, figure 3 Rules to object to lookup engine to dictionary and correlation table as described col 10, lines 25 – 55).

#### **Claim 3**

The framework of Claim 1, wherein each tag is registered with a centralized file so that the tags can be collectively referenced (**Malcolm**, figure 3, dictionary).

#### **Claim 4**

The framework of Claim 1, wherein the application page includes source code having wire frames (**WFT**, page 4-29, shows a drill down view of the Check budget rule), with the tags being included within the source code (**Malcolm**, teaches the connection of rules to objects and HTML (tagged language) figure 3 Rules to object to lookup engine to dictionary and correlation table as described col 10, lines 25 – 55).



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**Claim 5**

The framework of Claim 1, wherein the application page includes source code having master template HTML files, with tags being included within the source code (**Malcolm**, col 10, lines 25 – 55).

**Claim 6**

The framework of Claim 1, wherein the actions include action workflows ( **WFT**, page 4-27, Rules and conditions )

**Claim 7**

The framework of Claim 6, wherein the action workflows affect display results (**WFT**, Check budget example of claim 1 citation ), including returning HTML snippets to the rendered display result (**Malcolm**, figure 3, HTML pages to Browser/JAVA Interpreter NOTE – Examiner is pointing at the test generator side of the Malcolm reference because both lead to the browser which supports HTML) .

**Claim 8**

The framework of Claim 6, wherein the action workflows perform results that are not associated with a display result (**WFT**, execution of a RULE that does not generate a window display – Template is an object oriented workflow system – this limitation is interpreted to be the execution of a method that does not generate a display – mere execution of a method, Using page 4-48 shows a tab method of entering rules – rules are methods).

**Claim 9**

The framework of Claim 1, wherein the at least one rule is stored in a storage device for searchable reference and retrieval. (**Malcolm**, col 11, lines 5 - 21)

**Claim 10**

The framework of Claim 9, wherein a rule manager and deployment tool ( Template, Workflow system, **WFT**, 4-17 to 4-18 and Using 4-48)is provided which includes:

at least one interface for creating and storing new rules (**WFT**, 4-17 to 4-18andUsing 4-48)

at least one interface for searching and retrieving a list of existing rules (**Malcolm**, Fig 3, correlation table to lookup table to dictionary); and

at least one interface for selectively associating the actions of desired rules with certain tags that are associated with the application pages (**Malcolm**, Fig 3, correlation table to lookup table to dictionary).

**Claim 11**

The framework of Claim 9, wherein an interface is further included to search the available tags in order to determine which application or application pages would be able to handle deployment of a particular action. (**Malcolm**, Fig 3, correlation table to lookup table to dictionary).

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**Claim 12**

The framework of Claim 10, wherein a validation interface is further included to validate whether a particular action can be assigned to a particular tag (**Malcolm**, Fig 3, correlation table to lookup table to dictionary).

**Claim 13**

The framework of Claim 10, wherein the tool is provided as an online application whereby rules can be deployed on a runtime basis for a set of applications and applications pages (**WFT**, via interface 4-17 to 4-18 but also **Malcolm** the updating of pointers col 7 lines 44 to 55 in figure 3 the pointers are in the object generator).

**Claim 14**

**WFT** teaches a framework for implementing and deploying personalized rules(**WFT**, page 4-27, Rules and conditions) for performing certain actions in association with at least one application running on a processor(**WFT**, in example for over budget the action is a REFUSAL): in a distributed computer network (**WFT**, a distributed Workflow system – page 1-3 Deploying a WFT Workflow System – nodes and servers) :, the framework comprising:

- at least one rule having a set of conditions(**WFT**, page 4-27, Rules and conditions), the set of conditions being associated with an arbitrary action; at least one application page associated with each application(**WFT**, page 4-27, Rules and conditions); and

Although **WFT** teaches rules in a workflow system and generates HTML (**WFT**, 2-18), **WFT** does not teach the framework implemented in a tagged environment. It is **Malcolm** who teaches the framework for definition of tagged language in support of implementing Rules.

- at least one tag defined in a known location of the at least one application page (**Malcolm**, figure 3 Rules to object to lookup engine to dictionary and correlation table as described col 10, lines 25 – 55),

- at least one tag defined in a known location of the at least one application page, wherein a rule is deployed by associating the arbitrary action with certain tags, with the arbitrary action being executed when the tag is encountered in rendering the application page, and the set of conditions for the rule are satisfied(**Malcolm**, figure 3 Rules to object to lookup engine to dictionary and correlation table as described col 10, lines 25 – 55 – Also Rules by definition as stated in objection to Figure 1).

Therefore, it would have been obvious to combine the teaching of **WFT** with **Malcolm** , because the it allows for automatic code generation (**Malcolm**, col 2, lines 65 to end)

**Claim 15**

The framework of Claim 14, wherein the arbitrary action implements a predetermined interface which will then interact with the framework according to known parameters (**Using**, page 4-48, Variables).

**Claim 16**

The framework of Claim 15, wherein the framework is extensible with additional actions being incorporated via the predetermined interface. (**Using**, page 4-48, **WFT**, 4-27).

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**Claim 17**

**WFT** teaches a tool for implementing and deploying personalized rules for performing certain actions in association with at least one application running on a processor rules (**WFT**, page 4-27, Rules and conditions) in a distributed computer network (**WFT**, a distributed Workflow system – page 1-3 Deploying a WFT Workflow System – nodes and servers), the tool comprising:

- at least one interface for creating rules having a set of conditions(**WFT**, page 4-27, Rules and conditions), the set of conditions being associated with at least one action(**WFT**, in example for over budget the action is a REFUSAL), whereby the rules are retrievably stored;

- at least one interface for searching and retrieving a list of created and existing rules (**Using**, 4-48); and at least one interface for deploying -the rules by selectively associating the actions of certain rules (**WFT**, page 4-27, Rules and conditions)

Although **WFT** teaches rules in a workflow system and generates HTML (**WFT**, 2-18), **WFT** does not teach the framework implemented in a tagged environment. It is **Malcolm** who teaches the framework for definition of tagged language in support of implementing Rules.

- at least one tag defined in a known location of the at least one application page (**Malcolm**, figure 3 Rules to object to lookup engine to dictionary and correlation table as described col 10, lines 25 – 55),

- with certain tags, each tag having been defined in a known location of the at least one application, wherein the action is executed when the tag is encountered in the process of rendering the application, and the set of conditions for the associated rule are satisfied(**Malcolm**, figure 3 Rules to object to lookup engine to dictionary and correlation table as described col 10, lines 25 – 55).

Therefore, it would have been obvious to combine the teaching of **WFT** with **Malcolm** , because the it allows for automatic code generation (**Malcolm**, col 2, lines 65 to end).

**Claim 18**

The tool for implementing and deploying personalized rules according to Claim 17, wherein the tool is provided as an online application for implementing rules on a runtime basis without interrupting the running of computers comprising the distributed computer network. (**Malcolm**, col 7, lines 44 – 55 updating of pointers)

**Claim 19**

The tool for implementing and deploying personalized rules according to Claim 17, wherein the tags are registered in a searchable file. (**Malcolm**, col 5, lines 25 – 40).

**Claim 20**

The tool for implementing and deploying personalized rules according to Claim 19, wherein an interface is additionally provided to search for appropriate tags with which certain actions can be associated. (**Malcolm**, lookup engine figure 3, col 5 lines 25 – 40).

*Correspondence Information*

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Todd Ingberg** whose telephone number is (703) 305-9775. The examiner can normally be reached during the following hours:

Monday	Tuesday	Wednesday	Thursday	Friday
6:15 – 1:30	6:15- 3:45	6:15 – 4:45	6:15-3:45	6:15-130

This schedule began December 1, 2003 and is subject to change.

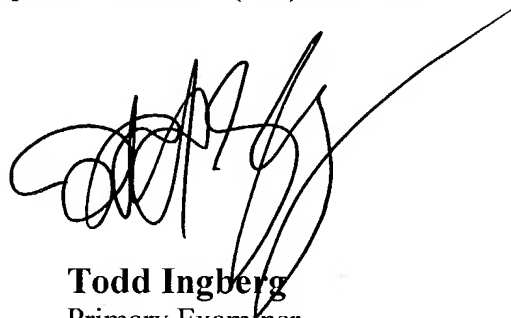
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Kakali Chaki** can be reached on (703) 305-9662. Please, note that as of August 4, 2003 the **FAX number** changed for the organization where this application or proceeding is assigned is **(703) 872-9306**.

Also, be advised the United States Patent Office **new address** is

Post Office Box 1450

Alexandria, Virginia 22313-1450

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.



**Todd Ingberg**  
Primary Examiner  
Art Unit 2124  
July 24, 2004